

REMARKS

By this Response, Applicant has canceled claim 2 without prejudice or disclaimer, amended claims 1, 16, 20, 47, 49, 51, and 53-55, and added new claim 56. No new matter has been added. Support for the amendments to claims 1, 47, 49, 51, and 53-56 may be found at least in paragraphs [018], [022], and [063], and in claims 2, 49, and 53 of the originally-filed application. Thus, claims 1, 3-9, 11-38, and 40-56 remain pending in the application for examination on the merits.

In the Office Action, claims 1-9, 11-13, 16, 18, 19, and 47-52 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by International Patent Application No. WO 99/51815 to Husband et al. ("Husband"). Office Action at 2. Claims 1, 8, 10-17, 20-36, 38, 40-46, 54, and 55 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by International Patent Application No. WO 00/59840 to Golley et al. ("Golley"). Id. at 5. Claim 37 was rejected under 35 U.S.C. § 103(a) as allegedly being obvious based on Golley in combination with U.S. Patent No. 6,186,335 to Arrington-Webb et al. ("Arrington-Webb").

Claims 1, 21, 38, 47, 51, 54, 55, and new claim 56 are the only independent claims pending in the application. Concerning the rejections of independent claims 1, 47, 51, 54, and 55, Applicant has amended those claims and respectfully submits that those claims comply with 35 U.S.C. § 102(b) and § 103(a) for at least the reasons outlined in more detail herein. Nevertheless, to the extent that the Examiner considers rejecting those claims based on the references of record in the application, Applicant respectfully submits that independent claims 1, 47, 51, 54, and 55 are patentably

distinguishable from those references, and such claim rejections would be improper for at least the reasons outlined herein. With respect to the rejection of remaining independent claims 21 and 38, Applicant respectfully traverses the § 102(b) rejection of those claims based on Golley for at least the reasons outlined in more detail herein.

I. Claim Rejection under § 102(b) based on Husband

With respect to the rejection of independent claims 1, 47, and 51 based on Husband, Applicant respectfully submits that Husband does not disclose all of the subject matter recited in each of those amended independent claims. Thus, Applicant respectfully requests reconsideration and withdrawal of the claim rejection.

According to the M.P.E.P., "[t]o anticipate a claim, the reference must teach every element of the claim." M.P.E.P. §2131. Each of Applicant's amended independent claims 1, 47, and 51 recites, *inter alia*, kaolin having "a Hercules viscosity of less than about 4000 rpm at 18 dynes at 63% solids when measured using an 'A' bob." Husband fails to disclose at least this subject matter recited in independent claims 1, 47, and 51.

The rejection statement refers to page 41, lines 17-23, and page 42, lines 6-9, as disclosing the subject matter recited in independent claims 1, 47, and 51. Office Action at 2-4. Applicant respectfully submits that the cited portions of Husband do not supply any disclosure related to viscosity. For at least this reason, Husband does not disclose each element of the claims, and Applicant respectfully requests reconsideration and

withdrawal of the §102(b) rejection of independent claims 1, 47, and 51 based on Husband.

II. Claim Rejection under § 102(b) based on Golley

Concerning the rejection of claims 1-8, 10-17, 20-36, 38, 40-46, 54, and 55 under § 102(b) based on Golley, claims 1, 21, 38, 54, and 55 are the only independent claims included in that claim rejection. Applicant respectfully traverses the rejection of those independent claims because Golley does not disclose all of the subject matter recited in each of those claims for at least the reasons outlined in more detail below. See M.P.E.P. § 2131.

A. Amended Independent Claim 1

Amended independent claim 1 recites, *inter alia*, “kaolin having an esd of less than about 0.25 μm [that ranges] from about 35% to about 60% by weight” In contrast, Golley discloses a pigment product where “less than 35% by weight of the particles have an esd smaller than 0.25 μm .” Golley at 12. Therefore, Golley does not disclose all of the subject matter recited in independent claim 1, and Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claim 1 under 35 U.S.C. § 102(b) based on Golley.

B. Independent Claims 21, 38, 54, and 55

Independent claims 21 and 38, directed to methods of refining kaolin, each recite, *inter alia*, “providing a degritted kaolin slurry” And amended independent claims 54 and 55, directed to methods of making a kaolin slurry, each recite, *inter alia*, “dewatering degritted kaolin with an evaporator” Although the rejection statement asserts that Golley discloses “grinding a degritted kaolin slurry composition comprising at le[a]st 50 weight % of particles having an esd less than 2 μ m,” Applicant respectfully submits that Golley does not disclose either providing or dewatering degritted kaolin. Office Action at 5, 7 (internal citations omitted).

The rejection statement refers to page 13, line 29, through page 14, line 3, in purported supported of its assertion. Applicant respectfully submits that the portion of Golley referred to by the rejection statement relates to a raw kaolin clay crude and, in particular, it discloses “mixing a raw kaolin crude . . . with water,” followed by “diluting [.] subjecting the suspension to attrition grinding . . . [.] and separating the suspension” before classification. Golley at 13, l. 29 thru 14, l. 13. None of Golley’s disclosed steps of mixing, diluting, attrition grinding, and separating correspond to providing or dewatering degritted kaolin, as recited in independent claims 21, 38, 54, and 55. At least because Golley does not teach this subject matter, and further, because it does not disclose how to degrit a kaolin clay, Golley does not teach all of the subject matter recited in independent claims 21, 38, 54, and 55. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claims 21, 38, 54, and 55 under 35 U.S.C. § 102(b) based on Golley.

III. Rejection of Dependent Claim 37 under § 103(a)

Turning now to the rejection of claim 37 under 35 U.S.C. § 103(a) based on Golley in combination with Arrington-Webb, Applicant respectfully submits that the rejection statement's hypothetical combination of Golley and Arrington-Webb fails to disclose or render *prima facie* obvious all of the subject matter recited in claim 37. For example, claim 37 depends from independent claim 21 and should be patentably distinguishable from Golley for at least the reasons outlined above with respect to the rejection of independent claim 21 based on Golley. Moreover, Arrington-Webb fails to supply the subject matter recited in claim 21 that is not supplied by Golley. For at least this reason, claim 37 is not *prima facie* obvious based on the Golley and Arrington-Webb references, regardless of whether they are viewed individually or as a whole. Thus, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 37 under 35 U.S.C. § 103(a).

IV. New Independent Claim 56

New independent claim 56 is directed to a coated paper, "wherein gloss of the coated paper is greater than about 45 TAPPI units." Applicant respectfully submits that none of the references of record discloses or renders *prima facie* obvious at least this subject matter recited in new independent claim 56. Therefore, new independent claim 56 should be allowable.

V. Conclusion

For at least the above-outlined reasons, Applicant's independent claims 1, 21, 38, 47, 51 and 54-56 should be allowable. Pending dependent claims 3-9, 11-20, 22-37, 40-46, 48-50, 52, and 53 depend from a corresponding one of the allowable independent claims. Therefore, those dependents claim should be allowable for at least the same reasons the corresponding independent claims are allowable.

Applicant respectfully requests the reconsideration of the application, withdrawal of the claim rejections, and timely allowance of pending claims 1, 3-9, 11-38, and 40-56.

If the Examiner believes that a conversation might advance prosecution of this application, the Examiner is cordially invited to call Applicant's undersigned attorney at (404) 653-6559.

Applicant respectfully submits that the Office Action contains a number of assertions concerning the related art and the claims. Regardless of whether those assertions are addressed specifically herein, Applicant respectfully declines to automatically subscribe to them.

Please grant any extensions of time required to enter this Response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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Dated: August 25, 2008

By: 

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